

### Remarks

In the January 13, 2003 Office Action, the Examiner objected to the specification and the declaration on grounds that the application contains additional disclosure. The Examiner maintained the rejection of claims 1 and 3-8 under 35 U.S.C. § 112, first paragraph. The Examiner also maintained the rejection of the claims under 35 U.S.C. § 102(b) based upon EP 633,043 to Higuchi.

Applicants respectfully submit that in view of the clarifying explanations submitted herein, all claims 1 and 3-8 are in condition for allowance.

**A. Objection to the Specification and Declaration Is Improper and Should Be Withdrawn**

The Examiner contended that "this application adds and claims additional disclosure, it must be changed to a continuation-in-part application instead of a divisional." Specifically, the Examiner asserted:

**Specification** The specification is objected to under 37 CFR 1.63(d)(iii) and 37 CFR 1.78. The applicant has improperly stated that this application is a divisional of prior Application No. 08/631,316 [sic, 08/631,613]. Because this application adds and claims additional disclosure, it must be changed to a continuation-in-part application instead of a divisional. Applicant should note that with a continuation-in-part application the new subject matter presented in the instant case is not entitled to any date prior to the instant application's filing date of September 10, 1997.

**Oath/Declaration** The declaration is objected to under 37 CFR 1.63 as being an improper divisional application. The declaration states that this application is a divisional of Application No. 08/631,613, however, this application adds substantial subject matter not presented in the prior application. The declaration must be changed to reflect the additionally recited subject matter and state that this application is a continuation-in-part of Application No. 08/631,613.

Page 2 of January 13, 2003 Office Action (bracketed text added).

The present application is a divisional of U.S. Serial No. 08/631,613 filed April 10, 1996, now U.S. Patent 5,803,831 which is a CIP of U.S. Serial No. 08/591,046 filed January 25, 1996, now abandoned; and a CIP of U.S. Serial No. 08/542,793 filed October 13, 1995, now abandoned, which is a CIP of U.S. Serial No. 08/070,510 filed June 1, 1993, now abandoned.

The Examiner argues that the present application is not a divisional of 08/631,613; but instead is a CIP. The Examiner asserts that the present

application "adds and claims additional disclosure" (apparently as compared to the '613 application).

The Examiner fails to identify what the "additional disclosure" is. If, the Examiner is referring to the subject matter that was previously at issue under § 112, first paragraph, and which the Board previously addressed, that discussion is presented below. The Examiner is respectfully reminded that upon reviewing whether the subject matter at issue was properly supported by the originally filed application, the Board held:

[W]e note that each specific limitation which the examiner has found to lack proper support in the originally filed specification appears to find proper support in the originally filed claims which are part of the originally filed specification.

Page 3, Appeal No. 2002-0260, Application No. 08/926,872.

It is indisputable that if the disputed subject matter is properly supported by the originally filed specification, then it is not new matter (citations omitted). The Board held that the disputed subject matter appears to be properly supported. Accordingly, the present application is not a CIP of 08/631,613.

Applicants are also puzzled as to why the Examiner would wait for a time period of over five (5) years since the filing date of the present application to now contend that the present application is not a divisional of 08/631,613. Furthermore, it is disconcerting that the Examiner would wait until this rather late stage of prosecution, i.e. in a final Action, and make such an assertion.

Applicants respectfully request that the objection be withdrawn.

#### **B. Rejection of Claims 1 and 3-8 Under § 112 Must Be Withdrawn**

In support of this ground of rejection, the Examiner contended:

Claims 1 and 3-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 - the core with a specific gravity less than 1.4 is non-enabling. Applicant discloses a specific gravity of 1.47 and 1.17, one of which is over the 1.4 limitation. The remaining values in the range is non-enabling subject matter. The limitation requires the specific gravity to be less than 1.4 or from 0 to 1.4. The specific gravity of the intermediate layer is not enabling. The claim requires the intermediate layer to be less than 1.2. Obviously 1.3 is outside the range in question. The values 0.953 and 0.960 cited on page 24 of the specification are specific gravity values for the base

ionomer and not the actual composition of the intermediate layer. Therefore the only value relevant to the intermediate layer having a specific gravity less than 1.2 is the value 0.95. The JIS-C hardness from 85 to 89.9 of the intermediate layer is not enabling. Applicant discloses a Shore D hardness of at least 60, which converts to approximately 90 on the JIS-C scale.

Claim 6 - the difference of 0.1 to 0.5 between the core and the intermediate layer specific gravity is not enabling. Again values within the claimed range have been shown but the entire range is not enabling.

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In response to previous explanations as to this issue, the Examiner further asserted:

Applicant's arguments filed November 4, 2002 have been fully considered but they are not persuasive. Applicant argues the 112, enablement rejection and recites MPEP 2164, p.2100-174. Applicant has been advised to add the subject matter to the specification however, the application type must be changed from a divisional to a continuation-in-part as shown above. Since applicant has not changed the type of the application the 112, first paragraph has been maintained. Applicant also argues the examiner's view is ill-advised and the enablement requirement has been satisfied. The Examiner disagrees. Applicant's attention is directed to MPEP 2164.04, pgs. 2100-178 and 2100-179 stating: "(examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled the disclosure)."

The sections also add:

The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. (emphasis added)

MPEP 2164.04 makes clear that the claims of the application should be rejected under 35 USC 112, 1st paragraph as containing subject matter which was not described in the specification to enable one of ordinary skill in the art to make and/or use the invention as claimed. As shown above the examiner has satisfied the rejection under 35 USC 112, 1st paragraph by specifically noting portions of the specification where the scope of enablement is not commensurate with that being sought by the instant claims.

Regarding applicant's question as to why certain dimensions are enabled by the instant specification while others are not, it should be abundantly clear to applicant that those dimensions recited in the claims and set forth by the specification are enabled while those that are recited in the claims but not set forth by the specification are not enabled.

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In rejecting the claims under § 112 for alleged lack of enablement, the Examiner attempts to ignore or bypass the long recognized standard test for

determining whether claimed subject matter is sufficiently enabled by a specification.

The standard for determining whether the specification meets the enablement requirement was set forth in *Mineral Separation v. Hyde*, 242 U.S. 261,270 (1916), as "is the experimentation needed to practice the invention undue or unreasonable?" And, according to § 2164.01 of the MPEP, this standard is "still the one to be applied." See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." See *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988).

Applicants respectfully urge the Examiner to read the explanation as to how the present specification enables the claims, presented on pages 4 to 8 of the previous Response filed on October 28, 2002.

The Examiner's assertions in the present case concerning non-enablement are directed to certain values of specific gravity and hardness. That is, the Examiner contends that although certain values are enabled by the present specification, other values are not enabled.

Applicants question how some specific gravity and hardness values are enabled, while other specific gravity and hardness values are not enabled? The Examiner admits that the specification discloses ranges of specific gravity and hardness used in the various components of the claimed golf balls. The Examiner demands that identical values be given in the specification for every value claimed. It is clear that the Examiner is demanding a significantly higher standard for enablement than that which the law requires.

As the Court of Appeals for the Federal Circuit pronounced, all that is required is that one reasonably skilled in the art be able to make or use the invention from the disclosure in the patent coupled with information known in the art, without undue experimentation.

The present specification, coupled with information known in the art, readily enables one skilled in this field of art to make and use, without undue

experimentation, golf balls with cores and/or layers having the claimed specific gravity or hardness values.

Apparently, the Examiner's sole basis upon which the present rejection is based, is that several values of specific gravity and hardness are not identically disclosed in the specification. Apparently, the Examiner is of the view that it would constitute undue experimentation to make a core with a specific gravity of less than 1.4 since the specification only discloses core specific gravities of 1.47 and 1.17. Similarly, it appears that the Examiner is of the view that it would constitute undue experimentation to form an intermediate layer having a specific gravity of less than 1.2 since the specification only discloses intermediate layer specific gravities of 1.2, 0.95, 0.953, 0.960 and numerous other values therebetween. Moreover, it appears that the Examiner believes it would constitute undue experimentation to produce an intermediate layer with a hardness of at least 85 Shore C since the specification only discloses several Shore D values for this layer.<sup>1</sup>

Contrary to the Examiner's assumptions, it would not constitute undue experimentation to form the noted cores and layers having the recited specific gravities and hardness values given that the present specification already provides several values and associated teachings, that are very near to those specified and claimed. The Examiner's view is incorrect and essentially amounts to a conclusion that a person in this field of art has no expertise in adjusting specific gravity or hardness.

It is respectfully submitted that the Examiner is proceeding along a misguided course. The Examiner should refrain from attempting to surmise the extent of knowledge of one reasonably skilled in this field of art, the extent of information known in the art, and what may or may not constitute undue experimentation. The MPEP states in this regard, "The examiner should never make the determination [of enablement] based on personal opinion." § 2164.05 MPEP, (bracketed text added, emphasis in original).

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<sup>1</sup> Apparently, the Examiner recognizes the fact that Shore C values may be converted to Shore D values and vice versa.

**C. Rejection of Claims 1 and 3-8 Under § 102 Must Be Withdrawn**

In support of this ground of rejection, the Examiner argued:

The earliest filing date from which applicant can claim priority for the claimed subject matter is the filing date of the instant application therefore the following rejection applies:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Higuchi (EP 633043A).

Pages 3-4 of January 13, 2003 Office Action.

In response to previously submitted reasons why the rejection is improper, the Examiner further contended:

Regarding the rejection under 35 USC 102(b), the rejection is maintained. The claimed subject matter does not obtain the benefit of the earlier filing dates. The application incorrectly claims priority to parent applications that it is not entitled.

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The Examiner's rejection is based upon the incorrect assumption that the pending claims are only entitled to the filing date of the present application which is September 10, 1997.

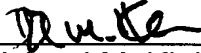
The present application claims priority upon an application that was filed prior to the earliest effective date of the EP 633,043 document cited by the Examiner. The present application claims priority upon U.S. Serial No. 08/070,510 filed June 1, 1993, now abandoned. That application significantly predates the earliest date of the EP '043 application, which is January 11, 1995.

**D. Conclusion**

In view of the clarifying explanations submitted herein, it is respectfully urged that claims 1 and 3-8 be allowed.

Respectfully submitted,

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